REMARKS

Entry of Response Under 37 C.F.R. § 1.116

This Response reiterates and emphasizes the distinctions of the claims of this application over the references used to reject the claims under 35 U.S.C. §§ 102 and 103, as previously discussed in the Response to Office Action dated January 24, 2006 (hereinafter, the "previous Office Action response"). As discussed further below, these distinctions were not addressed in the present Office Action. Applicants believe that this Response (particularly in view of the remarks presented in the previous Office Action response) places the application in condition for allowance. Accordingly, Applicants request entry of this Response under 37 C.F.R. § 1.116.

Rejection of Claims and Summary of Response

Claims 2-9, 41, 43-54 and 57-77 are pending. Claims 2-9, 41, 43-54 and 68-76 were rejected under 35 U.S.C. § 102. Claims 57-67 and 77 were rejected under 35 U.S.C. § 103. Reconsideration and allowance of Claims 2-9, 41, 43-54 and 57-77 is requested.

Rejection of Claims under 35 U.S.C. §§ 102 and 103

In the Office Action, Claims 2-9, 41, 43-54 and 68-76 were rejected under 35 U.S.C. § 102 as being anticipated by U.S. Patent No. 5,168,151 issued to Nara, and Claims 57-67 and 77 were rejected under 35 U.S.C. § 103 as unpatentable over U.S. Patent

No. 5,168,151 issued to Nara in view of U.S. Patent No. 5,905,245 issued to Tanaka.

In response to Applicants' remarks in the previous Office Action response regarding the above-indicated claim rejections, the Office Action states:

> Applicant argues in substance that (a) Nara does not teach "means for operating the interface device in a standalone mode in which the interface device is not operably connected to a host device to enable communication between the interface device and the host device"; (b) Nara does not teach "an integrated circuit card interface device ... as recited in claim 43; and (c) Nara and Tanaka do not teach or suggest an integrated circuit card ... as recited in claim 57.
>
> Examiner respectfully traverses Applicant's remarks.
>
> As to point (a), Nara teaches means for operating *(off-line function)* the interface device in a standalone mode *(standalone mode)* in which the interface device is not operably connected *(being disconnected from)* to a host device *(a terminal/a personal computer/an external apparatus)* to enable communication between the interface device and the host device *(col. 2, lines 17-33; col. 4, lines 46-51; and col. 7, lines 60-67)*.
>
> As to point (b), as shown through the mapping provided in the claim rejections, Nara meets each limitation of claim 43.
>
> As to point (c), Tanaka is combined with Nara to teach enable one or more programs to be added to, and/or deleted from, the interface device *(the IC card reading/writing control unit has ... a pass-through function to control read-out/write-in processing for the IC card by an application unit in a host for the IC card reading/writing apparatus by receiving a pass-through command from the host; see the Abstract; col. 5, lines 50-53; and col. 7, line 52 - col. 8, line 4)*.

The foregoing remarks in the Office Action merely re-state Applicants' conclusions in the previous Office Action response, then refute those conclusions by re-stating part of the rationale given in the Office Action dated August 24, 2005 (hereinafter,

the "previous Office Action") for rejecting the claims. The remarks in the present Office Action do not address any of the arguments made by Applicants in the previous Office Action response in support of the conclusions reached in that Office Action response.

As discussed in the previous Office Action response (see page 2 and the top of page 3), Nara teaches a portable electronic device that can be, in particular, an IC card. Nara also describes an IC card reader/writer into which can be inserted an IC card in accordance with the invention of Nara. As stated in the previous Office Action response, "the [previous] Office Action incorrectly identifies aspects of an IC card taught by Nara as representing elements of an integrated circuit card interface device as recited in the claims of this application." As further stated in the previous Office Action response, "[i]t is the IC card reader/writer described by Nara, rather than the IC card, that is analogous to the integrated circuit card interface device of the instant application." This misapplication of the teaching of Nara has not been addressed at all in the present Office Action, as must be done to sufficiently address Applicants' arguments in the previous Office Action response.

More particularly, regarding Claim 69, the present Office Action does not address Applicants' contentions that Nara does not teach or suggest an integrated circuit card interface device including "means for operating the interface device in a standalone mode in which the interface device is not operably

connected to a host device to enable communication between the interface device and the host device" (and, in particular, that Nara does not teach or suggest such means in the parts of the Nara patent identified in the previous Office Action, i.e., column 2, lines 17-33; column 4, lines 46-51; and column 7, lines 60-67 of the Nara patent), as recited in Claim 69, nor, in fact, any operation in any particular mode of the IC card reader/writer described in the Nara patent, but that, instead, Nara teaches operation of an IC card (which is not an integrated circuit card interface device) in an on-line mode or an off-line mode (as discussed, for example, at column 2, lines 17-24 of the Nara patent). The foregoing is discussed in detail at pages 4-6 of the previous Office Action response, and the Examiner is requested to review, consider and respond to the particular remarks presented there.

Further, regarding Claim 43, the present Office Action does not address Applicants' contention that Nara does not teach or suggest an integrated circuit card interface device that "is adapted to enable operation in ... a standalone mode of operation in which the interface device is not operably connected to a host device via the host interface," as recited in Claim 43. Nor does the present Office Action address Applicants' contention that Nara does not teach or suggest an integrated circuit card interface device including an application memory, application engine and/or input/output module as recited in Claim 43 (the teaching of Nara identified in the Office Action concerns parts of an IC card, not an IC card reader/writer), or an integrated

circuit card interface device including the associated functionality. The former contention is discussed in detail at pages 4-6 of the previous Office Action response, as indicated above, while the latter contention is discussed in detail at pages 8-9 of the previous Office Action response; the Examiner is requested to review, consider and respond to the particular remarks presented in both of those sections of the previous Office Action response.

Finally, regarding Claim 57, the present Office Action does not address Applicants' contention that neither Nara nor Tanaka teaches or suggests an integrated circuit card interface device including an application memory, application engine and/or input/output module as recited in Claim 57. Nor does the present Office Action address Applicants' contentions that Tanaka does not teach or suggest an integrated circuit card interface device that "is adapted to enable operation in accordance with ... a programming mode of operation in which the interface device is operably connected to an integrated circuit card via one of the one or more integrated circuit card interfaces, and/or to a host device via the host interface, to enable one or more programs to be added to, and/or deleted from, the interface device" (and, in particular, does not teach or suggest the capacity for such operation in the parts of the Tanaka patent identified in the previous Office Action, i.e., column 5, lines 50-53 and column 7, line 52 to column 8, line 4 of the Tanaka patent), as recited in Claim 57, but that, instead, Tanaka teaches apparatus in which an application unit that controls read-out/write-in processing for

an IC card is stored, and whether an IC card reading/writing apparatus can enable control of read-out/write-in processing for an IC card by an application unit stored on either apparatus. The former contention is discussed in detail at pages 8-9 of the previous Office Action response, as indicated above, while the latter contention is discussed in detail at pages 11-12 of the previous Office Action response; the Examiner is requested to review, consider and respond to the particular remarks presented in both of those sections of the previous Office Action response.

In view of the foregoing, it is requested that the rejection of Claims 2-9, 41, 43-54 and 68-76 under 35 U.S.C. § 102, and the rejection of Claims 57-67 and 77 under 35 U.S.C. § 103, be withdrawn.

CONCLUSION

Claims 2-9, 41, 43-54 and 57-77 were pending and were rejected. In view of the foregoing, it is requested that Claims 2-9, 41, 43-54 and 57-77 be allowed. If the Examiner wants to discuss any aspect of this application, the Examiner is invited to telephone Applicants' undersigned attorney at (408) 945-9912.

I hereby certify that this correspondence is being transmitted via facsimile to the U.S. Patent and Trademark Office, Group Art Unit 2194, facsimile number (571) 273-8300, on June 28, 2006.

6-28-06 David R. Graham
Date Signature

Respectfully submitted,

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